

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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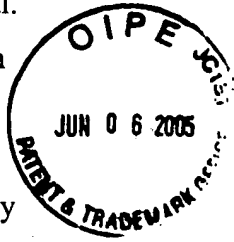
Applicant: Robert O. Martin et al.

Title: Liner'Wear Detection

Docket No.: KMG2007

Filed: September 25, 2003

Examiner: Gail Kaplan Verbitsky



Serial No.: 10/670,586

Due Date: July 5, 2005

Group Art Unit: 2856

MS Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

X A return postcard and this transmittal document.

X An PETITION FROM REQUIREMENT FOR RESTRICTION UNDER 37 CFR § 1.144 (4 Pages).

LAW OFFICE OF STANLEY K. HILL, PLC

Customer Number: 36732

By

Stanley K. Hill
Stanley K. Hill
Reg. No. 37548

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3 day of June, 2005.

MEREDITH MESCHER
Name

Meredith Mescher
Signature

(GENERAL)

S/N 10/670,586

PATENT

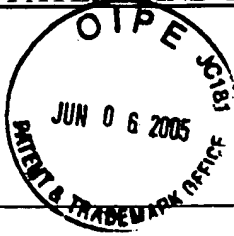
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Title: Liner Wear Detection



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PETITION FROM REQUIREMENT FOR RESTRICTION UNDER 37 CFR § 1.144

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant has reviewed the Office Action mailed on April 5, 2005. In that Office Action, the Examiner's election/restriction requirement was made FINAL. Applicants hereby petition the Director to review the requirement.

REMARKS

During a telephone interview with the Examiner on August 31, 2004, the undersigned made a provisional election with traverse to prosecute the invention of Group II (i.e., Claims 1-4 and 10-13). In the Office Action dated September 23, 2004, the Examiner rejected the claims of Group II and indicated that Applicants must affirm the election in replying to the Office Action of September 23, 2004. On December 30, 2004, Applicants filed a Response to the Office Action of September 23, 2004.

In the Response filed December 30, 2004, Applicants canceled the claims of Group II as well as Claims 26-29, 31, and 35-38 and amended Claims 5, 7, 30, 32, 33, and 39. In the Response filed December 30, 2004, Applicants also requested reconsideration of the restriction requirement. In requesting reconsideration of the restriction requirement, Applicants stated the following:

As stated in MPEP §806.04(A), two different combinations are independent only if they “are not disclosed as capable of use together and” (emphasis added) Thus, if they are disclosed as capable of use together, then they can not be considered independent. Both the description and claims of the present specification clearly teach that the embodiments of the claims in Groups I and II are certainly capable of use together.

The specification as a whole, and especially at page 15, lines 1-8, clearly indicates that Group I and Group II are capable of use together. In fact, a preferred embodiment uses a wire thermocouple to measure both temperature and electrical resistance. This is made expressly clear in Claims 18-25, wherein the placed electrically conductive wire thermocouple is used in both measuring the electrical resistance and in monitoring the temperature. Thus, not only are Groups I and II capable of use together, preferred embodiments have them integrally combined. Accordingly, the restriction requirement of Groups I and II is inappropriate and Applicants respectfully request this restriction requirement by [SIC] withdrawn.

As stated in MPEP §806.04(B), “where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent.” The invention as embodied in the apparatus claims (i.e., Claims 30, 32-34, and 39-42) can be used to practice the processes of the method claims (i.e., Claims 5-9 and 14-25) because the electrically conductive wire thermocouple required by the apparatus claims can be used to perform the step of monitoring the temperature, which is required by all the process claims.

Accordingly, a restriction requirement of the present claims, as herein amended, is inappropriate. Applicants respectfully request that the existing restriction requirement be withdrawn and that the present claims, as herein amended, not be subject to further restriction requirement.

In the Office Action mailed April 5, 2005, the Examiner stated that "the election/restriction requirement is still deemed proper and is therefore made FINAL." The Examiner further states the following:

... Applicant states that the thermocouple (Invention II) is used to measure both, the temperature and the electrical resistance. This is not found persuasive because, the method of Invention I (claims 5-9, 14-25) is one embodiment (as admitted by applicant in pages 14-15 of the specification), directed to measuring of wear of a liner by means of determining the wear of an electrical wire, which, although could be used with a thermocouple wire, is different from the method of Invention II (claims 1-4, 10-13) which method is another embodiment (as admitted by applicant in pages 14-15 of the specification), directed to determining a temperature (not wear) of the thermocouple (not an electrical resistance of its wire), and estimating the wear as a function of this temperature over time.

Applicants agree that the present specification teaches the detection of wear by measuring electrical resistance and teaches the detection of wear by measuring temperature over time. Applicants also agree these constitute two different methods of estimating wear. However, Applicants argue that embodiments utilizing one method are not properly restricted from embodiments utilizing the other method because the methods can be used together as explained in the specification at page 15, lines 1-8 and as embodied in Claims 18 and 30. That is, a single device (i.e., an electrically conductive wire thermocouple) can be used to estimate wear using both methods. This redundancy of measuring wear using two different methods is a valuable safety feature.

Applicants contend that the restricted claims are not independent and the restriction requirement is improper. Applicants respectfully request that the restriction requirement be removed and the pending claims be examined on their merits.

The Examiner is invited to telephone Applicant's attorney (989-297-1298) to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No 50-3019.

Respectfully submitted,

ROBERT O. MARTIN ET AL.

By their Representatives,

Customer Number 36732
Telephone Number (989) 297-1298

Date 6/3/05

By Stanley K Hill
Stanley K Hill
Reg. No. 37548

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3 day of June, 2005.

MEREDITH MESCHER

Name

Meredith Mescher

Signature